

## **REMARKS**

### **I. PRELIMINARY REMARKS**

A minor amendment has been made to the specification. Claim 15 has been canceled. Claims 8, 11, 12 and 16 have been amended. Claims 18-25 have been added. Claims 8-14 and 16-25 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes that the discussion of the rejection on page 2 of the Office Action failed to provide any indication whatsoever as to which portions of the Hampton device purportedly correspond to the elements of the claimed inventions. The discussion is, instead, nothing more than a listing of the elements set forth in independent claim 8. Applicant hereby requests that any subsequent Office Action link the elements recited in each of the claims to the elements in the cited reference(s) by Figure numbers, reference numerals, and citations to column and line numbers. [See 37 C.F.R. § 1.104(c)(2) and MPEP § 707.]

### **II. PRIOR ART REJECTIONS**

#### **A. The Rejections**

Claims 8-12 and 15-17 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,940,062 to Hampton ("the Hampton patent"). Claims 13-14 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Hampton patent and U.S. Patent No. 4,848,352 to Pohndorf ("the Pohndorf patent"). As claim 15 has been canceled, the rejection thereof under 35 U.S.C. § 102 has been rendered moot. The rejections of the remaining claims under 35 U.S.C. §§ 102 and 103 are respectfully traversed to the extent that they are applicable to the claims as amended above. Reconsideration thereof is respectfully requested.

**B. Discussion Concerning Claims 8-12, 16 and 17**

Independent claim 8 calls for a combination of elements comprising "a main body portion defining a proximal end and a distal end and including a malleable portion fixedly positioned between the proximal and distal ends," "a deflectable portion extending distally from the distal end of the main body portion and deflectable relative to the main body portion," "a steering mechanism, operably connected to the deflectable portion, that bends the deflectable portion relative to the main body portion" and "at least one operative element carried by the deflectable portion." The respective combinations defined by claims 9-12, 16 and 17 include, *inter alia*, the elements recited in claim 8.

The Hampton patent is directed to a guide member with a deflectable tip. Referring to Figure 1, the Hampton guide member includes a tubular element 12, a helical coil 13 extending distally from the tubular element, and a core element 11 that extends through the tubular element and helical coil, and is secured to the distal end of the helical coil by a plug 22. The helical coil includes an expanded section 16 with a flat reference element 18 mounted therein. So configured, movement of the core element 11 causes the expanded section 16 and reference element 18 to deflect in the manner indicated by arrow 40. [Column 4, lines 24-46.] Turning to Figure 5, the Hampton patent also indicates that the guide member illustrated in Figure 1 may be incorporated into a dilation catheter with a dilation balloon 47. The Hampton patent also discloses that the flattened section 24 of the core 11 may be manually bent. [Figure 12; column 5, line 64 to column 6, line 12.]

The Hampton patent fails to teach or suggest a variety of aspects of the combination defined by independent claim 8. For example, it appears that the Office Action has taken the position that the tubular element 12 corresponds to the "main body portion," the helical coil 13, which deflects relative to the tubular element 12, corresponds to the claimed "deflectable portion," and the dilation balloon 47 corresponds to the claimed "operative element." Even assuming for the sake of argument that this is a reasonable interpretation of claim 8, the purported "operative

element," i.e. the dilation balloon 47, is not carried by the purported "deflectable portion," i.e. the helical coil 13.

Additionally, to the extent that the Office Action has taken the position that the flattened section 24 of the Hampton core element in Figure 12 corresponds to the "malleable portion," the flattened section 24 is not located between the proximal and distal ends of the purported "main body portion," i.e. the tubular element 12. Alternatively, to the extent that the Office Action has taken the position that the entire core element 11 corresponds to the "malleable portion," the core element 11 is not "fixedly positioned between the proximal and distal ends" of the purported "main body portion," i.e. the tubular element 12. Instead, the core element 11 is free to move proximally and distally relative to the tubular element 12.

As the Hampton patent fails to teach or suggest each and every element of the combination recited in independent claim 8, applicant respectfully submits that claims 8-12, 16 and 17 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

### **C. Discussion Concerning Claims 13 and 14**

With respect to the rejection under 35 U.S.C. § 103, applicant respectfully submits that the Pohndorf patent fails to remedy the above-identified deficiencies in the Hampton patent. As such, claims 13 and 14 are patentable for at least the same reasons as independent claim 8. Applicant also notes for the record that the Pohndorf "pacing lead" patent would not have suggested adding electrodes to a guiding member such as that disclosed in the Hampton patent. The rejection of claims 13 and 14 under 35 U.S.C. § 103 should, therefore, also be withdrawn.

### **III. NEWLY PRESENTED CLAIMS 18-25**

Newly presented claims 18-20 depend from independent claim 8 and, therefore, are patentable for at least the same reasons as claim 8.

Newly presented independent claim 21 calls for a combination of elements comprising "a tubular catheter body including a tubular malleable portion and a distal portion that is distal of the tubular malleable portion," "a steering spring mounted within the tubular distal portion," "at least one steering wire that extends through the tubular malleable portion and is connected to the steering spring" and "at least one electrode carried by the distal portion of the tubular catheter body." The Hampton and Pohndorf patents fail to teach or suggest the claimed combination. For example, the Hampton and Pohndorf patents fail to teach or suggest a tubular malleable portion and a steering wire that extends therethrough. Applicant respectfully submits, therefore, that claims 21-25 are patentable over the Hampton and Pohndorf patents.

#### **IV. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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Date

/Craig A. Slavin/

Craig A. Slavin

Reg. No. 35,362

Attorney for Applicant

**Henricks, Slavin & Holmes LLP**

840 Apollo Street, Suite 200

El Segundo, CA 90245

(310) 563-1458, (310) 563-1460 (Facsimile)